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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

OMURA et al.

Atty. Ref.: 468-30

Appln. No. 09/914,286

Group Art Unit: 1646

Filed: August 24, 2001

Examiner: N.T. Nashed

FOR: AVERMECTIN AGLYCON SYNTHASE GENES

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RESPONSE TO RESTRICTION REQUIREMENT

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May 30, 2003

TECH CENTER 1600/2900

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the pending Office Action (Paper No. 9) mailed May 14, 2003, entry and consideration of the following remarks are respectfully requested.

Claims 1-43 are pending. Applicants elect Group I (claims 1-29, 31-38 and 43) with traverse for examination on the merits. Applicants reserve the right to prosecute nonelected subject matter in a further patent application.

Reconsideration of the restriction requirement is requested.

Initially, it is noted that no lack of unity was found during the International phase of examination. Claims 1-43 were the subject of both the Int'l Search Report and the Int'l Preliminary Examination Report. Neither the Japanese nor the European Patent Office has found a lack of unity.

Traverse is based on the lack of a showing that examining the claims of at least Groups I-IV would constitute an undue burden. Although the inventions identified by the Examiner are separately patentable, both the need for compact prosecution and the public interest would be served by examination of all of these claims in a single application.

The different amino acid sequences identified by the Examiner are patentably distinct, but it would not constitute an undue burden for more than one sequence to be examined in this application because, in particular, the M.P.E.P. § 803.4 refers to the sua sponte waiver of 37 CFR 1.141 et seq. and states that "up to ten independent and

distinct nucleotide sequences will be examined in a single application without restriction" (emphasis added). Therefore, at least claims 1-29, 31-38 and 43 should be examined with respect to SEQ ID NOS:1-6 (i.e., Groups I-IV).

Not related
species

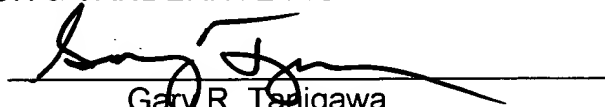
In the alternative, it is noted that claims 1-2 are generic or linking claims and that examination should proceed under the provisions of M.P.E.P. § 809. As described on pages 19-26 of the specification, SEQ ID NOS:1-2 comprise open reading (i.e., avermectin aglycon synthase genes) frames which encode multifunctional enzymes. Therefore, the amino acid sequences encoded thereby (e.g., SEQ ID NOS: 3-6) are structurally related species of the invention described by generic or linking claims 1-2. Furthermore, the sequences are functionally related because they encode polypeptides having avermectin aglycon synthase activity. Here, the sequences are contiguous and related to the same biosynthetic pathway. They are both structurally and functionally related, even though patentably distinct.

Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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